Claims 1-20 are pending in the application. New claim 20 has been added; no new matter has been added. Support for new claim 20 can be found at least in the specification in FIG. 4; page 10, line 14 – page 12, line 2; page 5, lines26-34.

Claims 5-9 stand rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully disagrees.

The Examiner's Answer indicates that

> In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed function: The specification on page 5 paragraph (0050) teaches how the server may retrieve identification of a user. However, the specification and drawings do not disclose sufficient corresponding structure, material or acts for performing the claimed function. The Specification and claims 5 and 6 indicate that the server retrieves information in the form hand-carried application device such as web tablet.

> However, the Specification does not set forth any structures (e.g., circuits or components) or processors with software instructions or algorithms, which are to be added to application devices so as to allow them to interact with the server to enable document retrieval by the server from the application devices. As such, Appellant has

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failed to adequately describe sufficient structure for performing the function claimed.

Applicant respectfully disagrees.

Page 5, lines 27-34 reads:

In the rest of this document, the term server may also be understood as a document adaptation server. Generally, the server may have or have received a given set of (first) input documents from the application devices comprising of user and context information. The server then uses it intelligence to compute and or to generate a (second) set of output documents, which are sent to the application devices. The server may use the context and the user profile contained in the first set of documents to calculate the content and a structure in the second set of documents, which may describe what each application device that participates in the user experience should do.

Applicant respectfully submits that one skilled in art at the time of the invention would clearly know that:

a server computer is a computer, or series of computers, that link other computers or electronic devices together. They often provide essential services across a network, either to private users inside a large organization or to public users via the Internet. For example, when you enter a query in a search engine, the query is sent from your computer over the internet to the servers that store all the relevant web pages. The results are sent back by the server to your computer. Many servers have dedicated functionality such as web servers, print servers, and database servers..

Hardware requirements for servers vary, depending on the server application. Absolute CPU speed is not usually as critical to a server as it is to a desktop machine. Servers' duties to provide service to many users over a network lead to different requirements like fast network connections and high I/O throughput. Servers often run for long periods without interruption and availability must often be very high, making hardware reliability and durability extremely important. Although servers can be built from commodity computer parts, mission-critical servers use specialized hardware with low failure rates in order to maximize uptime. For example, servers may incorporate faster, higher-capacity hard drives, larger computer fans or water cooling to help remove heat, and

> uninterruptible power supplies that ensure the servers continue to function in the event of a power failure. These components offer higher performance and reliability at a correspondingly higher price. Hardware redundancy—installing more than one instance of modules such as power supplies and hard disks arranged so that if one fails another is automatically available—is widely used. ECC memory devices which detect and correct errors are used; non-ECC memory is more likely to cause data corruption.See http://en.wikipedia.org/wiki/Server_(computing)

Accordingly, claims 5-9 comply with 35 USC 112, second paragraph, and particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant respectfully requests removal of these rejections.

Claims 1-19 stand rejected under 35 USC 102(e) as being anticipated by Ficco et al. (USP 6,868,292, hereinafter "Ficco"). Applicant respectfully disagrees.

MPEP 2131 states:

> "A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Board of Patent Appeals and Interferences has consistently upheld the principle that the burden of establishing a prima facie case resides with the Office, and to meet this burden, the Examiner must specifically identify where each of the claimed elements are found in the prior art:

"there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). To meet [the] burden of establishing a prima facie case of anticipation, the examiner must explain how the rejected claims are anticipated by pointing out where *all* of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection." *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005).

Claim 1, upon which claims 2-4 and 7-11 depend, claims a method that includes retrieving first documents from a first set of application devices by a server; retrieving an identification of a user by the server; autonomously generating second documents by the server, each comprising at least one instruction, on the basis of at least a part of the retrieved identification of the user and at least a part of the first documents; sending at least one of the second documents to each device of a second set of the application devices by the server; and performing, for a given device of the second set, one instruction from at least one of the second documents received in the given device. Independent claims 5, 12 and 20 and their respective dependent claims, include similar limitations.

Ficco fails to teach generating second documents on the basis of at least a part of the retrieved identification of the user and at least a part of first documents and sending at least one of the second documents to each device of a second set of the application devices by the server, and performing, for a given device of the second set, one instruction from at least one of the second documents received in the given device.

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The Final Office Action asserts that Ficco teaches generating second documents on the basis of at least a part of the retrieved identification of the user and at least a part of first documents and sending at least one of the second documents to each device of a second set of the application devices by the server. The Final Office Action asserts that Ficco provides this teaching at column 16, lines 1-4 and lines 62-67. The Appellant respectfully disagrees with this assertion. At the first cited text (column 16, lines 1-4), Ficco teaches:

"Transmitter 910 may also include a high-frequency oscillator that generates a carrier wave, and a high-frequency mixer that modulates the carrier with the baseband signal to generate a narrowband transmit signal." (Ficco, column 16, lines 1-4)

As is evident, the cited text fails to teach generating second documents on the basis of at least a part of a retrieved identification of the user, as specifically claimed in claims 1, 5 and 12.

At the second cited text (column 16, lines 62-67), Ficco teaches:

"This present invention is not limited to these methods of script selection. Alternatively, and instead of selecting scripts to be downloaded from the internet, STB 300 may be configured to receive scripts that are downloaded from a satellite system, and/or to receive …from a satellite TV or cable provider…"

Although Ficco's script selection may be from second sources, it specifically fails to teach generating second documents on the basis of at least a part of a retrieved identification of the user, as specifically claimed in independent claims 1, 5, 12 and 20.

The Examiner's Answer further indicates in column 17 lines 1-2 this section mentions a customer is able to select and pay for a particular "pay-per-script" event; and that this shows that a selective script is retrieved from a user's choice. Which in turn teaches "generating second documents on the basis of at least a part of a retrieved identification of the user." Applicant respectfully disagrees.

Although, the user is able to select for a particular event (e.g. user's choice) it still does not teach "generating second documents on the basis of at least a part of the retrieved identification of the user and at least a part of first documents…" In other words, second documents are not generated using the retrieved identification of the user or a first document. A user simply <u>selects</u> any other event/document from a service provider. In fact the identification of the user is irrelevant for the selection of documents, but is needed only to gain access to service provider's system. See col. 18, lines 32-39.

Because Ficco fails to teach each of the elements of each of the Appellant's independent claims 1, 5 and 12, and because the Final Office Action fails to identify where Ficco provides the teachings of each of the elements of claims 1, 5 and 12, the Appellant respectfully maintains that the rejection of claims 1-19 under 35 U.S.C. 102(e) over Ficco is unfounded, per MPEP 2131, and should be withdrawn. Appellants respectfully submit that claims 1, 5, 12 and 20 are allowable.

With regard to claims 2-4, 6-11, and 13-19 these claims depend from an independent claim discussed above, which have been shown to be allowable in view of the cited

reference. Accordingly, each of claims 2-4, 6-11, and 13-19 are also allowable by virtue of its dependence from an allowable base claim.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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